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New York, NY 10004

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DEC 13 2004

OFFICE OF PETITIONS

In re Application of	:
Hans-Joerg Mathony	:
Application No. 09/960,571	: DECISION DISMISSING
Filed: September 21, 2001	: PETITION
Attorney Docket No. 10191/1917	:

This is a decision on the "Second Request for Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001, Petition and Statement Under 37 C.F.R. § 1.6(e) and Petition Under 37 C.F.R. § 1.183" filed June 7, 2004, again requesting that the above-identified application be accorded a filing date of September 12, 2001.

A request that the above-identified application be accorded a filing date of September 12, 2001, was submitted with the application papers on filing. A decision dismissing the request was mailed on December 18, 2003. On February 19, 2004, a first request for reconsideration and petition under 37 CFR 1.183 was filed. A decision dismissing the request for reconsideration and petition was mailed on April 6, 2004.

On September 21, 2001, 37 CFR 1.6(e) stated that:

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

35 U.S.C. 21(a) states that:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the

United States Postal Service but for postal service interruptions or emergencies designated by the Director. (Emphasis added.)

In the first decision, it was acknowledged that the U.S. Patent and Trademark Office (Office) designated the interruption in the service of the USPS in the borough of Manhattan as a postal service interruption and emergency within the meaning of 35 U.S.C. 21(a), with the provisions of 37 CFR 1.6(e) in effect, and also designated the interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e). See “United States Postal Service Interruptions”, 1251 *Off. Gaz. Pat. Office* 55 (October 9, 2001).

As stated in the prior decisions, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for **postal service** interruptions or emergencies. Thus, the statute requires that: (1) the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by applicants, and (2) the complete application papers could not be deposited with the USPS for the **sole reason** that the postal service was not available due to the interruption or emergency designated by the Office.

Petitioner continues to disagree with this statement as to what the statute requires and argues that the request fully complies with the requirements of 35 U.S.C. 21(a) and 37 CFR 1.6(e). Petitioner argues that the statute does not impose any substantive requirements on applicants and that the language of the statute “indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date earlier than the actual date of receipt.” Petitioner cites the legislative history for support. Petitioner further argues that 37 CFR 1.6(e) merely requires applicant to submit “a statement indicating that such correspondence would have been filed on a particular date if it were not for the designated interruption or emergency in the United States Postal Service.” Since such a statement has been submitted, petitioner argues that the Office must accord the application a filing date of September 12, 2001.

As indicated in the previous decision, the Office does not have the authority to promulgate rules that would exceed its statutory authority. Thus, the Office can only accord a filing date under 37 CFR 1.6(e) where the requirements of 35 U.S.C. 21(a) have been met, namely, that the correspondence would have been deposited with the United States Postal Service but for the postal service interruption or emergency designated by the Director. Where the Office has reason to believe that a statement under 37 CFR 1.6(e) may not be true, it has the inherent authority to question the statement to determine whether the applicant is, in fact, entitled to the requested filing date under 35 U.S.C. 21(a) and 37 CFR 1.6(e). In this case, there is evidence that clearly contradicts the statement that was made on filing since the transmittal letter for the application was dated September 21, 2001.

The first decision noted that the transmittal letter for the application was dated September 21, 2001, and stated that it did not appear that the application was prepared and ready to be deposited with the USPS on September 12, 2001. The first request for reconsideration filed February 19, 2004 failed to address this issue. The previous decision mailed April 6, 2004 indicated that the fact that the applicants' attorney's office was inaccessible to the attorney on September 12, 2001, due to the World Trade Center attack and the attorney was diligent in filing the application papers once his office resumed its normal operations would not be sufficient to establish that the application was ready to be deposited with the USPS on September 12, 2001; that the record shows that the transmittal letter for the application was dated September 21, 2001; and that the Office simply cannot accept applicant's statement when the evidence contradicts the statement and applicants have not provided an adequate explanation or additional evidence to show that the application papers were complete and ready to be deposited with the USPS on September 12, 2001.

The first request for reconsideration and petition filed February 19, 2004 was accompanied by a "Statement of Dervis Magistre..." in which Mr. Magistre states that he "was personally responsible for preparing the above-captioned application for filing in the United States Patent and Trademark Office" and he "had completed the application papers, i.e., the four pages of Specification, the one page containing five claims, the one page of Abstract, and the two pages of Figures, that were deposited with the United States Postal Service on September 21, 2001, no later than September 12, 2001." The previous decision mailed April 6, 2004 noted that this statement of Mr. Magistre was made approximately two years and five months after the application was filed. No objective evidence to corroborate Mr. Magistre's statement that he completed the application papers that were deposited with the USPS on September 21, 2001, no later than September 12, 2001, was submitted. The previous decision indicated that "it was unclear how an individual involved in the day-to-day preparations of papers for filing in the USPTO can recall exactly what papers were completed by 'no later than' a particular date when those papers were prepared approximately two years and five months earlier."

In the second request for reconsideration filed June 7, 2004, petitioner points to the wording of 37 CFR 1.137(b), which requires a statement that the entire delay was unintentional and reserves the authority of the USPTO to require additional information where there is a question, and to 37 CFR 1.137(a), which requires a showing to the satisfaction of the Director that the entire delay was unavoidable. Petitioner argues that the MPEP makes a distinction between a statement and a showing and that 37 CFR 1.6(e) merely requires a statement, not a showing.

The requirements of petitions under 37 CFR 1.137 are not relevant. While 37 CFR 1.6(e) requires a statement and does not explicitly require a showing, the Office has the inherent authority to question the statement to determine whether the applicant is entitled to the requested filing date under 35 U.S.C. 21 (a) and 37 CFR 1.6(e) where the Office has reason to believe that the statement under 37 CFR 1.6(e) may not be true. The fact that 37 CFR 1.137(b) explicitly

indicates that the Director may require additional information or that 37 CFR 1.137(a) requires a showing simply does not negate the fact the Office has the inherent authority to question a statement under 37 CFR 1.6(e). The Office has the inherent authority to require additional information. For example, 37 CFR 1.105 was promulgated to give examiners and other Office employees the explicit authority to require submission of such information reasonably necessary for the Office to properly treat a matter. The promulgation of 37 CFR 1.105 was based on the Office's inherent authority to require applicants to reply to requirements for information under 35 U.S.C. 131 and 132.

Furthermore, petitioner does not dispute that the transmittal letter was signed on September 21, 2001, and indicates that applicant only seeks to having a filing date of September 12, 2001 accorded to the four pages of specification, one page of five claims, one page of Abstract, and two sheets of drawings that were mailed on September 21, 2001. Petitioner argues that these papers constitute a complete application under 35 USC 111(a) and 37 CFR 1.53(b).

While it is acknowledged that a transmittal letter is not required for a complete application, here the transmittal letter is evidence that the application papers may not have been complete and ready to be deposited on September 12, 2001, since the date on the transmittal letter is a date later than the filing date requested. The transmittal letter was part of the Express Mail package that included the application papers and it serves as evidence as to when the application papers were ready for deposit. The Office cannot simply ignore the fact that the date on the transmittal letter is a date later than the filing date requested. As noted above, the Office cannot accept applicant's statement under 37 CFR 1.6(e) when the evidence contradicts the statement and applicants have not provided an adequate explanation or additional evidence to show that the application papers were complete and ready to be deposited with the USPS on September 12, 2001.

In addition, the second request for reconsideration was accompanied by a "Second Statement of Dervis Magistre..." with Exhibits A-E. Petitioner argues that the second statement of Mr. Magistre provides sufficient evidence that the application papers for which a filing date of September 12, 2001, were complete and ready to be deposited with the USPS on the filing date requested. Petitioner states that Exhibit A is a copy of a letter dated May 30, 2001 from the assignee to Kenyon & Kenyon that establishes that Kenyon & Kenyon had possession of the German priority application prior to September 12, 2001. Petitioner further states that Exhibit B is a printed record of activity history related to the word processor document that contains the specification, claims, and abstract of the application and Exhibit C is a printed record of activity history related to the word processor document that contains the transmittal form for the application. Petitioner explains that the word processor document that contains the specification, claims and abstract of the application was printed for the last time before the requested September 12, 2001 filing date on August 31, 2001. Therefore, petitioner argues that the specification, claims and abstract were complete and ready to be deposited on September 12,

2001. Petitioner also explains that the word processor document that contains the transmittal form of this application was printed for the last time before the requested September 12, 2001 filing date on September 5, 2001.

As to Exhibit A, while the German priority application may have been in the possession of Kenyon & Kenyon prior to September 12, 2001, the application papers that were actually filed on September 21, 2001, are not the same as the German priority application. As to Exhibits B and C, there is no indication on these documents that they relate to the present application and there is no indication as to how the information contained in the documents relates to the present application. Furthermore, the printed records do not show any documents that contain the drawings for the application. Thus, even if the applicant can provide evidence that the documents are related to the present application, there is no evidence that the drawings for the application were complete and ready to be deposited with the USPS on September 12, 2001.

Petitioner states that Exhibit D is a copy of a letter dated September 4, 2001 from Kenyon & Kenyon to the assignee and Exhibit E is an English-language translation of the German-language letter of Exhibit D. Petitioner argues that this letter establishes that the application papers for which a September 12, 2001 filing date is sought were complete and ready to be deposited on September 12, 2001.

37 CFR 1.52(b) provides that the application and other papers must be in the English language or be accompanied by a translation into the English language along with a statement that the translation is accurate. If petitioner wants to rely on the German-language letter, then a statement that the translation is accurate is required. Furthermore, it is not clear from the letter that the copy of the U.S. application that was purportedly enclosed with the letter is the same as the application papers that were actually filed on September 21, 2001. Petitioner should consider submitting a copy of what is in the assignee's file of what was sent to them on September 4, 2001, by Kenyon & Kenyon, with some evidence of receipt by the assignee. Petitioner should also indicate that the copy is the same as the application papers (i.e., specification including claims, drawings, and abstract) that were filed on September 21, 2001, if, in fact, that is the case.

For the reasons noted above, the evidence of record is not sufficient to show that the application papers were complete and ready to be deposited with the USPS on September 12, 2001.

In the alternative, petitioner again requests that the alleged requirements of 37 CFR.1.6(e) be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application. Petitioner argues that the events of September 11, 2001, constitute "an extraordinary situation" under 37 CFR 1.183, and justice requires that the Office accord a filing date of September 12, 2001 to the present application. Petitioner argues that no suspension of waiver of any statutory requirement is necessary since the statute merely authorizes the Director to promulgate a rule and does not impose any obligation on applicants.

37 CFR 1.183 states, in part, that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party subject to such other requirements as may be imposed. (Emphasis Added.)

As noted above, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for postal service interruptions or emergencies. 37 CFR 1.183 does not give the Office the authority to waive a requirement of the statute. Therefore, the petition under 37 CFR 1.183 cannot be granted.

It is again noted that the application includes a claim for foreign priority based on a German application filed September 12, 2000. An applicant may delay action until the end of the time period for taking action, but are acting at their own peril when doing so. See Ziegler et al. v. Baxter et al. v. Natta et al., 159 USPQ 378 (ComrPats 1968). Since the above-identified application has been accorded a filing date of September 21, 2001, which is more than one year after the filing date of the German application, the claim for foreign priority **cannot** be accepted.

The previous decision has been reconsidered as requested. The result, however, is the same.

In view of the above, the petition is dismissed.

Any request for reconsideration should be filed within **TWO MONTHS** of this decision in order to be considered timely (see 37 CFR 1.181(f)) and should be directed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Eugenia Jones
 Office of Patent Legal Administration

By hand: U.S. Patent and Trademark Office
 220 20th Street South
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-7727.

A handwritten signature in cursive script that reads "Eugenia A. Jones".

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy